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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,706	04/16/2004	Karl Rohrbaugh	R001-4529 (CIP)	9166
40627	7590	04/30/2007		
ADAMS & WILKS 17 BATTERY PLACE SUITE 1231 NEW YORK, NY 10004			EXAMINER JOHNSON, STEPHEN	
			ART UNIT 3641	PAPER NUMBER
			MAIL DATE 04/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/825,706

Applicant(s)

ROHRBAUGH ET AL.

Examiner

Stephen M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-12, 21-24, 27-30 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) 42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-24 and 27-30 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 37-41 and 43-50 is/are rejected.
- 7) ☒ Claim(s) 3-6 and 9-12 is/are objected to.
- 8) ☒ Claim(s) 1-6, 9-12, 21-24, 27-30 and 37-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

1. Applicant's election of the group II invention drawn to a semi-automatic handgun with a particular length, height, and thickness (dimensions) in the reply filed on 7/27/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-6, 9-12, 21-24, 27-30, 37-41, and 43-50 either read on the elected invention or link the elected invention and an action on these claims follows. Claim 42 is withdrawn from consideration as being directed to non-elected inventions.

2. Newly submitted claim 42 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claim 42 is directed to a semi-automatic hand gun containing a torsion spring with first and second ends attached in a particular configuration. This is considered to be invention IV directed to another subcombination usable together in a single combination. In this case, subcombination IV could be used with a semi-automatic firearm of different length, height, and thickness dimensions than those associated with elected subcombination II.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 42 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 38, and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Yates et al. (169).

Yates et al. (169) disclose a semi-automatic handgun comprising:

- |  |                |
|--|----------------|
| a) a frame;  | 43             |
| b) a barrel with peripheral wall portion, conical portion,<br>and cylindrical portion; | 30, 16, 32, 34 |
| c) a slide mounted on the frame;   | 12             |
| d) a firing mechanism for striking the cartridge; and                                  | 58             |
| e) a trigger.  | 60             |

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. (169) in view of Raville (249).

Yates et al. (169) apply as recited above. However, undisclosed is a semi-automatic firearm that is a 9 mm caliber firearm. Raville (249) teaches a semi-automatic firearm that is a 9 mm caliber firearm (col. 3, line 25). Applicant is substituting one caliber ammunition firearm for another in an analogous art setting as explicitly encouraged by the secondary reference (see col. 3, lines 16-32 of Raville). It would have been obvious to a person of ordinary skill in this art at

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the time of the invention to apply the teachings of Raville to the Yates et al. firearm and have a firearm of a particular caliber.

7. Claims 37 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. (169) in view of in re Kuhle, 526 F .2d 553, 188 USPQ 7 (CCPA 1975).

Yates et al. (169) apply as previously recited. However, undisclosed are the particular dimensional ranges listed in claims 37 and 47. Regarding these relationships, since no particular advantage, purpose, or problem is being solved by this particular choice of ranges, they are considered to be obvious matters of design choice (see in re Kuhle).

8. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. (169) in view of Roy (120).

Yates et al. (169) apply as previously recited. However, undisclosed is a handgun weighing between 12 and 12.9 ounces. Roy (12) teaches a handgun weighing between 12 and 12.9 ounces (see col. 4, lines 46-50). Roy teaches altering design features and material types to arrive at a selected firearm weight. It would have been obvious to a person of ordinary skill in this art to apply the teachings of Roy to the Yates et al. firearm and have a firearm weighing between 12 and 12.9 ounces.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardelli Model 60 (see page 85) in view of Lichtman (169).

Bernardelli teaches a semiautomatic handgun comprising:

- |                                  |                          |
|----------------------------------|--------------------------|
| a) a barrel and frame;           | see page 85              |
| b) a slide mounted on the frame; | see page 85              |
| c) a hammer and trigger;         | see page 85 illustration |

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d) a length of about 5.05 inches; and

see page 85 (6.5 inches)

e) a height of about 4.04 inches.

see page 85 (4.8125 inches)

Bernardelli Model 60 applies as recited above. The Bernardelli firearm must certainly have some associated thickness even though the reference is silent to the exact amount. Lichtman (169) teaches how a firearm of a similar length and height to the Bernardelli firearm is known to have a thickness of about .812 inches (see col. 10, lines 36-42 of Lichtman). Applicant is substituting the undisclosed thickness of Bernardelli for the disclosed thickness as taught by Lichtman in the confines of an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Lichtman to the Bernardelli Model 60 firearm and have a firearm with a particular thickness.

10. Claims 40-41, 43-46, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardelli Model 60 in view of Lichtman (169) as applied to claim 39 above, and further in view of Albercht et al. (519).

Bernardelli Model 60 and Lichtman (169) apply as previously recited. However, undisclosed is a means for facilitating interaction of the slide and barrel that consists of a tapering conical portion. Albercht et al. (519) teach a means for facilitating interaction of the slide and barrel that consists of a tapering conical portion 6. Albercht et al. explicitly teach the addition of conical portion 6 to aid in centering and force reduction between the sliding slide and the stationary barrel (see col. 6, lines 16-23 of Albercht et al.). Applicant is selecting and assembling material parts in an analogous art setting as explicitly encouraged by the secondary reference. It would have been obvious to a person of ordinary skill in this art at the time of the

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invention to apply the teachings of Albercht et al. to the firearm of Bernardelli Model 60 in view of Lichtman (169) and have a firearm with a particular type of means for facilitating interaction.

11. Claims 3-6 and 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 21-24 and 27-30 are allowed.

13. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

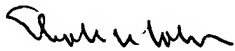
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 571-272-6877

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and whose e-mail address is ([Stephen.Johnson@uspto.gov](mailto:Stephen.Johnson@uspto.gov)). The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The Central FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 800-786-9199.



**STEPHEN M. JOHNSON**  
**PRIMARY EXAMINER**

Stephen M. Johnson  
Primary Examiner  
Art Unit 3641

SMJ  
April 26, 2007